

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 39-54 are amended without prejudice or disclaimer.

Rejection of Claims 39, 40, 42, 43 and 47-50 Under 35 U.S.C. §112

The Office Action rejects claims 39, 40, 42, 43 and 47-50 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have made minor amendments to claim 39 to address the appearance that the limitation "stored program information" does not have sufficient antecedent basis. Applicants note that the "determining" step of claim 39 follows the "wherein" term and is thus referring back to the step of determining whether stored information is out of date on lines 3 and 4.

Applicants have made a minor amendment to replace "that" with "whether" and deleted a ":" of claim 39 to clarify the connection between the determining steps of lines 3 and 9. Accordingly, Applicants submit that this claim now complies with 35 U.S.C. §112.

Applicants have amended claims 40, 42, 43 and 47-50 in order to address the antecedent basis issue for "the performance transmitter". Accordingly, Applicants respectfully request withdrawal of the Section 112 rejections.

Rejection of Claims 39-54 Under 35 U.S.C. §103(a)

The Office Action rejects claims 39-54 under 35 U.S.C. §103(a) as being unpatentable over Roop et al. (U.S. Patent No. 6,216,265) ("Roop et al.") in view of Greer et al. (U.S. Patent No. 5,978,828) ("Greer et al."). Applicants respectfully traverse this rejection and submit that one of ordinary skill in the art would not have sufficient motivation or suggestion to combine Roop et al. with Greer et al. Furthermore, Applicants have made a minor amendment in order to distinguish the claim set from Roop et al.

First, Applicants address the minor claim amendments to distinguish claims 39 and 46 from Roop et al. Applicants note that the step of detecting the need for performance information by determining that stored performance information is out of date is asserted to be taught by Roop et al. in columns 7, 10 and 73. Applicants have amended claims 39 and 46 to replace the word “information” with the word “content.” Thus, claim 39 recites a method for receiving performance content over a network for generating a pseudo-live performance. The method includes the step of detecting a need for performance content by determining whether stored performance content is out-of-date. Applicants shall explain that there is a fundamental difference between Roop et al. and claim 39 inasmuch as claim 39 clearly covers the performance content itself rather than just a schedule of data.

Roop et al. focus on a system and method for transmitting and utilizing electronic program guide information. The Abstract describes that a television schedule information transmission and utilization systems (50A-50D) transmit TV schedule data and associated network control messages provided by computer (54) as packets via the Video Blanking Interval (VBI) lines in a TV signal and from various television program providers (51). Applicants submit that there are numerous references to the fact that the data that is transmitted is program guide information or TV schedule data. See, e.g., column 1, lines 25-26; column 2, line 65; column 3, lines 2-3, 9, 12-13, 17-18, 22, 25, 28, 33; column 7, lines 6, 8-9, 17, 21, 26, 29-35; column 8, lines 23-27, 41-43, 46-50, 53-56, 63; column 9, lines 50-52; column 10, lines 12, 20-21; column 73, line 27. Thus, Applicant respectfully submit that the data that is transmitted in Roop et al. is limited to program guide information, TV schedule data, a program guide or listing. The teachings of Roop et al. are not broad enough to encompass the limitation of detecting a need for performance content by determining whether stored performance content is out-of-date. This is because of the focus in Roop et al. of managing the transmission and

updating of the TV schedule data. This difference will clearly weave through each of the limitations of claim 39 and provide multiple reasons why the first 4 steps of claim 39 are not taught by Roop et al.

The Office Action next asserts that the step of selecting a process for obtaining the needed performance information (content) is taught in column 7, lines 15-27. Applicants again note that column 7, lines 15-27 focus entirely on transmitting television schedule data that may be stored but this reference does not teach anything with regards to selecting a process for obtaining needed performance content. Accordingly, because column 7 is focused on scheduling data rather than the performance content itself, Applicants submit that this step is not taught in the reference.

Next, the Office Action asserts that the step of executing the process for obtaining the needed performance information (content) is also taught in column 7. Again, there is no discussion of executing a process for obtaining needed performance content in column 7 inasmuch as it is limited to television schedule data.

The Office Action next asserts that generating the pseudo-live performance by mixing information (content) corresponding to one or more portions of the needed performance information (content) with other information (content) is taught in columns 8 and 9. Applicants have cited multiple portions of columns 8 and 9 which indicate that its teachings are limited to managing the television schedule information rather than the content itself. For example, the portion of column 9 cited in the Office Action references that the data that is sent is used to build an "on-screen programming guide" that enables the systems subscribers to interactively view television program listings on their TV screen. Thus, there is no discussion of several features of this limitation of claim 39. First, there is no discussion of anything regarding a "pseudo-live performance". This actually is a concept of claim 39 that is not addressed in the Office Action.

The pseudo-live performance is based on the idea of having stored performance content that is mixed with other content. Thus, Applicants respectfully submit that the amendment to this limitation of claim 39 further clarifies and differentiates claim 39 from Roop et al. and easily distinguishes it from the teachings of Roop et al. in columns 8 and 9 which have been established to be limited to transmitting television schedule data rather than content. Accordingly, Applicants submit that there are numerous features of claim 39 that are not taught by Roop et al.

Next, the Office Action concedes that Roop et al. fail to teach of determining whether the stored program information (content) is out-of-date through various steps. Applicants note that Greer et al. has been highlighted as teaching these particular limitations. Inasmuch as the primary reference of Roop et al. fails to teach numerous limitations that even if combined with Greer et al., Applicants submit that claims 39 and 46 are patentable and in condition for allowance. Accordingly, for this substantive reason, Applicants submit that the claims are patentable.

Applicants next address the issue of whether one of skill in the art would have sufficient motivation or suggestion to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must

present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01, Section VI. *In re Ratti*, the court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." *Id.*

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to

one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With these principles in mind, Applicants first note that a primary reason why one of skill in the art would not combine these references is that they are not analogous to one another. MPEP 2141.01(a) requires under a 103 analysis that the art must be analogous. The Examiner must determine what is “analogous prior art” for the purpose of analyzing the obviousness of the subject matter at issue. In order to rely on the In re Oetiker case is cited which requires the following:

“In order to rely on a reference as a basis for rejection of an Applicant’s invention, the reference must either be in the field of the Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.”

The Office Action also cites In re Clay for the following:

“A reference is reasonable pertinent if, even though it may be in a different field from that of the inventor’s endeavor, is one to which, because of the matter with which it deals, logically would have commended itself to the inventor’s attention in considering his problem.”

Applicants shall explain that Roop et al. and Greer et al. are both non-analogous and because they are in different fields of art, Applicants submit that one of skill in the art would not have sufficient motivation or suggestion to combine these references.

Applicants first note that Roop et al. requires a satellite communication system. It is clear even from the title and abstract that what is required for communicating the TV schedule data is packets via the video blanking interval (VBI) lines in the TV signal for various television program providers. Inasmuch as this is a particular delivery mechanism for providing television programs, that the basic network in which the Roop et al. invention applies is shown in Figures

1-4. These all involve a space net or other kind of satellite and the particular header structure and channeling organization that is known in the art of satellite delivery of television programs. Therefore, one of skill in the art would be a person familiar with and working in the field of television scheduling and delivery.

Applicants respectfully submit that this field of endeavor differs from the teachings of Greer et al. This is easily established inasmuch as Greer et al. clearly focus on URL book mark notification of webpage content or location changes. The Abstract notes that their invention relates to an apparatus and method of providing notification of a content change to a webpage. Figure 1 illustrates their basic network. Figures 5-7 illustrate more detailed data regarding URLs and the technology necessary to interact in the World Wide Web. The fundamental reason why this is non-analogous to Roop et al. is that column 1, line 17 of Greer et al. explain that “the main piece of software used for connecting to and displaying webpages on a client is called a web browser. The main function of a web browser is to interpret the information received from a webpage and display it on a computer monitor. Most of today’s web browsers have a feature called bookmarks (or favorites). The feature allows a user to tag (or save) the address of uniform resource locator (‘URL’) of a favorite webpage and add a short description of the webpage in an address book.” (Emphasis added.)

Simply put, the required piece of software for the invention of Greer et al. is a web browser. A person of skill in this art would be one who is sufficiently familiar with the HTTP protocol and the programming of webpages and the utilization and transmission protocols for delivering web content. This is a very different mechanism for delivering content to a computer monitor than is the network of Roop et al. Roop et al. do not utilize URLs. Roop et al. do not utilize a web browser which, according to Greer et al. is a “main piece of software used for connecting to and displaying webpages.” Thus, these mechanisms are entirely different and

essentially involve people having different skills in order to understand and work in the technology. In other words, there would be no single person “of skill in the art” that would be expected to have the capability and the knowledge of both the context of Greer et al. and the context of Roop et al. Applicants respectfully submit that the context and teachings of Greer et al. would not “logically have commended themselves to an inventor’s intention in considering his problem.” MPEP 2141.01(a). The analogy in Section V of 2141.01(a) in the electrical arts is instructive. The Wang Laboratories, Inc. v. Toshiba Corp. case discussed claims that were directed to single in-line memory modules (SIMMs) for installation on a printed circuit mother board and for use on personal computers. The secondary reference was also found to discuss a SIMM for an industrial controller. The Federal Circuit held that the reference discussing a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. The reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. The Federal Circuit further found that since memory models of the claims at issue were intended for personal computers and used dynamic random access memories, whereas reference SIMMs were developed for use in large industrial machine controllers and were only taught the user of static random access memories or read-only memories, the finding that that reference was non-analogous was supported by substantial evidence. Applicants respectfully submit that there is substantial evidence to assert that because Roop et al. deliver a television signal and Greer et al. involve delivering web content, that these are not the same field of endeavor inasmuch as they, like the SIMMS in Wang Laboratoires, involve entirely different types of technologies and thus, would not be obvious to combine.

A further concept referenced above, applies directly to the analysis on page 4 of the Office Action. The Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Roop et al. with Greer et al. for the purpose of determining that stored data is old or out-of-date by comparing latest update times and time stamps.” Again, Applicants submit that this is a very difficult case to make inasmuch as there is no “one” person of skill in the art. The question remains, is the person of skill in the art one who is familiar with the art of satellite television broadcast delivery and TV schedule data processing? Or is the “one” person of skill in the art a person who understands the HTTP protocol and the details of delivering content to a web browser as in Greer et al. Given the complexity of these differing types of networks, Applicants submit that it would be very difficult to establish that the same person of skill in the art would cover both territories.

The Office Action asserts that the purpose of incorporating the teachings of Greer et al. would be to determine the data stored is old or out-of-date by comparing the latest update times with time stamps. Applicants note that it is unnecessary for this concept to be incorporated from Greer et al. because in the context of television schedule data, the idea of updating the television schedule data is already well established and completely articulated. For example, in column 7, in the portion cited in the Office Action, it explains that the system transmits television schedule data with an identification of the transmitted television schedule data by time relative to other transmitted television schedule data. The transmitted television schedule data is received with a subscriber data processing system and is stored in the memory of the system. Television schedule data that is subsequently supplied includes an identification by time relative to other television scheduled data. Identification by time of the subsequent supplied television scheduled data is compared with the identification by time of the television schedule data stored in the memory. The television schedule data is replaced with a subsequently supplied television data if

the identification by time of the subsequent supplied television schedule data is later than the identification by time of the stored television schedule data. Certainly, this covers the concept of “determining that stored data is old or out-of-date by comparing latest update times and time stamps.” The concept of time stamps would already be established by the included “identification by time” that is provided with the television schedule data. In this regard, Applicants simply submit that the motivation articulated in the Office Action fundamentally is redundant with teachings already found in Roop et al. Thus, there is no need, suggestion or motivation of one of skill in the art (assuming that the art in this case is transmission of television programs in Roop et al.) to look outside of the teachings of Roop et al. for time stamping issues.

It is already well established within Roop et al. how subsequent supplied television scheduled data would replace outdated schedule data. Accordingly, Applicants respectfully submit that there are numerous reasons why the obviousness analysis fails. There is substantive evidence that these are non-analogous arts and that Greer et al. should not be combined with Roop et al. based on the differing areas of art. Furthermore, even if they were to be found to be in the same area of art or analogous arts, Applicants submit that the preponderance of the evidence is on their side and that the very purpose that is articulated on page 4 of the Office Action to lead one of skill in the art to combine the references in reality does not exist inasmuch as Roop et al. already teaches the very feature that Greer et al. is asserted to supply.

Accordingly, Applicants respectfully submit that claims 39 and its dependent claims 40-45 are patentable and in condition for allowance. Similarly, Applicants submit that amended claim 46 and its dependent claims 47-54 are patentable and in condition for allowance.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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